

Serial No. 09/930,070
Amdt. dated February 16, 2005
Reply to Office Action of November 16, 2004

Attorney Docket No. CAS0049

REMARKS/ARGUMENTS

Claims 1 through 20 remain in this application. Claims 21 through 23 have been canceled without prejudice or disclaimer.

Claims 1 through 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 6,671,508 B1 to Mitsuoka, et al. (Mitsuoka, et al. patent) in view of U.S. 5,933,477 to Wu (Wu patent). Applicant respectfully traverses this ground for rejection for the reasons argued below.

In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988), the court stated that obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). It "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. "[T]eachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original). Applicant respectfully submits that the Office Action does not make out a *prima facie* case of obviousness, because the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Serial No. 09/930,070
Amdt. dated February 16, 2005
Reply to Office Action of November 16, 2004

Attorney Docket No. CAS0049

Claim 1 provides, *inter alia*, selecting an action based on the rule set of the subscriber using the communication priority and the subscriber status. Claim 14 provides, *inter alia*, computer readable program code to select an action based on the rule set using the communication priority and the subscriber status.

As stated at the second sentence of section 3 (page 2) of the above Office Action, the Mitsuoka, et al. patent fails to teach selecting an action based on the rule set of the subscriber using the communication priority and the subscriber status. Likewise, the Wu patent does not describe or suggest selecting an action based on the rule set of the subscriber using the communication priority and the subscriber status, as required by claims 1 and 14. The above Office Action references FIG. 5 and col. 3, lines 6 through 55, of the Wu patent, but neither of these sections of the Wu patent describe any type of action selection based on subscriber status, let alone selecting an action based on the rule set of the subscriber using the communication priority and the subscriber status, as required by claims 1 and 14. Therefore, claims 1 and 14 distinguish patentably from the Mitsuoka, et al. patent, the Wu patent, and the combination of these patents.

Claims 2 through 13 and 15 through 20 depend from and include all limitations of independent claims 1 and 14, respectively. Therefore claims 2 through 13 and 15 through 20 distinguish patentably from the Mitsuoka, et al. patent, the Wu patent, and the combination of these patents for the reasons stated above for claims 1 and 14.

Serial No. 09/930,070
Amtd. dated February 16, 2005
Rcply to Office Action of November 16, 2004

Attorney Docket No. CAS0049

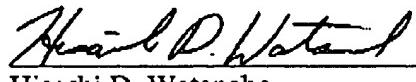
In view of the above, reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection of claims 1 through 20 are respectfully requested

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. Also, no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Commissioner is hereby authorized to deduct any additional fees arising as a result of this response, including any fees for Extensions of Time, or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

It is submitted that the claims clearly define the invention, are supported by the specification and drawings, and are in a condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Should the Examiner have any questions or concerns that may expedite prosecution of the present application, the Examiner is encouraged to telephone the undersigned.

Respectfully submitted,
Balasuriya, Senaka

 02/16/05
Hisashi D. Watanabe Date
Attorney for Applicant(s)
Registration No. 37,465
Telephone: (847) 523-2322
Facsimile: (847) 523-2350

Please forward all correspondence to:
Motorola, Inc.
Law Department (HDW)
600 North US Highway 45, AS437
Libertyville, IL 60048